

REMARKS

Claims 1-10 are pending in this application. By this amendment, Applicant amends claim 1, and adds claims 6-10.

Claims 1-4 were rejected under 35 U.S.C. §102(b) as being anticipated by Applicant's Admitted Prior Art Fig. 14 (AAPA). And claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over AAPA in view of Kubota et al. (U.S. 5,644,107). Applicant respectfully traverses these rejections.

Claim 1 has been amended to recite:

"A center-electrode assembly comprising:
a ferrite;
center-electrode patterns and insulating films deposited on the top surface of the ferrite;
a conductive pattern formed on the bottom surface of the ferrite;
and
connecting electrodes directly formed on margins of the ferrite; wherein
the connecting electrodes electrically connect the center-electrode patterns and the conductive pattern." (emphasis added)

New claim 10 recites features that are similar to the features recited in claim 1, including the emphasized features.

The Examiner alleged that AAPA teaches the present claimed invention including "connecting electrodes 271-273 located on the sides of the ferrite 270". Applicant respectfully disagrees.

AAPA teaches only two elements provided on the ferrite 270. Particularly, AAPA teaches only central electrodes 271-273 and a conductive pattern 276 which are directly connected to one another and are provided on the ferrite, and clearly fails to teach or suggest separate connecting electrodes which connect the center-electrode patterns with the conductive pattern. The Examiner has relied upon elements 271-273 to allegedly teach both center-electrode patterns and connecting electrodes. This is clearly improper because a single structural element taught by a prior art reference can't be relied upon to teach two separately and distinctly claimed elements.

In addition, the portion of the center-electrode patterns 271-273 located on the sides of the ferrite 270 are merely wrapped around the sides of the ferrite, and are clearly NOT "formed on margins of the ferrite" as recited in the present claimed invention.

Thus, AAPA clearly fails to teach or suggest "center-electrode patterns", "a conductive pattern" and "connecting electrode patterns" which "electrically connect the center-electrode patterns and the conductive pattern" as recited in the present claimed invention.

Accordingly, Applicant respectfully submits that AAPA fails to teach or suggest the unique combination and arrangement of elements recited in claims 1 and 10 of the present application.

Claim 5 recites:

"A method for manufacturing a center-electrode assembly, comprising the steps of:

forming through-holes in a ferrite mother board;

alternately depositing a center-electrode pattern and an insulating film on the top surface of the ferrite mother board, and forming a conductive pattern on the back surface of the ferrite mother board; and

cutting a center-electrode assembly from the ferrite mother board by cutting the ferrite mother board at intervals of a predetermined size, the center-electrode patterns formed on the top surface and the conductive pattern formed on the back surface being electrically connected via connecting electrodes formed in the through-holes in the center-electrode assembly."

The Examiner acknowledged that AAPA fails to teach or suggest any method including cutting an assembly from a ferrite mother board. However, the Examiner alleged that Kubota et al. teaches that a multilayer composite electronic component may be made by the method of starting from a laminated mother board and slicing along via holes to form electrodes. Thus, the Examiner concluded that it would have been obvious to have manufactured the device of AAPA using the method taught by Kubota et al. Applicant respectfully disagrees.

In contrast to the present claimed invention and the Examiner's allegations,

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Kubota et al. clearly fails to teach or suggest any center-electrode assembly, any center-electrode patterns, or any connecting electrodes which electrically connect the center-electrode patterns to a conductive pattern, and certainly fails to teach or suggest a method of manufacturing a center-electrode assembly including the step of "cutting a center-electrode assembly from the ferrite mother board by cutting the ferrite mother board at intervals of a predetermined size, the center-electrode patterns formed on the top surface and the conductive pattern formed on the back surface being electrically connected via connecting electrodes formed in the through-holes in the center-electrode assembly" as recited in the present claimed invention.

The mere fact that Kubota et al. teaches a method of manufacturing an entirely different type of electronic component by cutting a mother board, certainly does not render the method recited in claim 5 obvious, absent teachings in the prior art references of the specific method steps recited therein. Since neither AAPA nor Kubota et al. teach or suggest the specific method steps recited in claim 5, the Examiner has clearly failed to establish a *prima facie* case of obviousness. Instead of basing the conclusion of obviousness on actual teachings or suggestions of the prior art and the knowledge of one of ordinary skill in the art at the time the invention was made, the Examiner has improperly used Applicants' own invention as a guide. It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1784 (Fed. Cir. 1992).

Furthermore, since the electronic component of Kubota et al. is completely different from the center-electrode assembly of AAPA, and includes completely different elements, there would have been absolutely no motivation to combine the teaching of Kubota et al. with AAPA. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching,

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suggestion or incentive supporting the combination. In re Geiger, 815 F.2d 686, 2 USPQ 1276, 1278 (Fed. Cir. 1987).

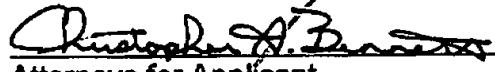
Accordingly, Applicant respectfully submits that AAPA and Kubota et al., taken individually or in combination, fail to teach or suggest the unique combination and arrangement of method steps recited in claim 5.

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1, 5 and 10 are allowable. Claims 2-4 and 6-9 depend upon claim 1, and are therefore allowable for at least the reasons that claim 1 is allowable.

In view of the foregoing amendments and remarks, Applicant respectfully submits that this application is in condition for allowance. Favorable consideration and prompt allowance are solicited.

The Commissioner is authorized to charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account No. 50-1353.

Respectfully submitted,


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VERSION WITH MARKINGS SHOWING CHANGES MADE

1. A center-electrode assembly comprising:
a ferrite;
center-electrode patterns and insulating films deposited on the top surface of the ferrite;
a conductive pattern formed on the bottom surface of the ferrite; and
connecting electrodes directly formed [at] on margins of the ferrite [electrically connecting between]; wherein
the connecting electrodes electrically connect the center-electrode patterns [deposited on the top surface] and the conductive pattern [formed on the bottom surface].

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